

**Amendments to the Drawings:**

Applicant has attached a Replacement Sheet for drawing Figure 1 for the Examiner's consideration. As required by the Examiner in the Office Action, Applicant has amended Figure 1 to show gripper 24.

### **REMARKS/ARGUMENTS**

Applicant gratefully acknowledges the Examiner's finding of allowable subject matter in dependent claims 5 and 6. Applicant has rewritten these claims in independent form and respectfully submits that these claims are now allowable. Further in this Amendment, Applicant has amended dependent claim 2 to now depend from rewritten independent claim 5 and has added new dependent claims 9-11, which depend from rewritten independent claim 6. Dependent claims 9-11 correspond to dependent claims 2-3 and 7, respectively, which depend from independent claim 5.

Applicant has also provided a revised drawing Figure 1 for the Examiner's consideration. Figure 1 has been amended to show the claimed gripper of claim 8. Applicant has also amended the specification at page 4 to refer to the gripper by reference numeral 24. Applicant respectfully submits that the Examiner's objection to the drawings has now been overcome.

Applicant has also rewritten dependent claim 8 in independent form. Applicant respectfully traverses the Examiner's rejection of dependent claim 8, as she best understood this claim. In the Office Action, the Examiner acknowledges that the modified Osburn reference does not disclose a gripper on the tool slide. The Examiner, however, argues that it would have been obvious to further modify Osburn to choose a different location for Osburn's gripper instead of being located at the disclosed workpiece feed area in Osburn. The Examiner argues that McMurtry teaches a different location for the gripper. However, Applicant respectfully submits that even if Osburn can be further modified by McMurtry, there is still no motivation, or disclosure, for locating the gripper on the tool slide as claimed by Applicant. McMurtry doesn't even disclose a gripper on a tool slide. In fact, McMurtry teaches away from any different location for its gripper. As disclosed at col. 5, lines 11-33, McMurtry discusses the criticality of attaching the "gripper 52", as argued by the Examiner, and its actuator 50, to a fixed gantry 51 "above the machine tool so that it lies outside of the working

volume of the machine tool.” Thus, the gripper is on a fixed gantry above a machine tool, and thus, outside of the working volume of the machine tool.

Therefore, Applicant respectfully submits that none of the references teach a gripper on the tool slide, as claimed by Applicant. To establish a *prima facie* case of obviousness, the references must teach or suggest all of the claim limitations. See M.P.E.P. ¶ 2143. Applicant respectfully submits that the Examiner’s argument that it would have been obvious to choose a different location for the gripper, “such as on the tool slide instead of the workpiece feed area”, as argued by the Examiner, does not meet the requirements for establishing a *prima facie* case of obvious. (underline emphasis added). There is no teaching in the references to locate the gripper on the tool slide. The Examiner merely argues that a different location can be chosen, “such as” on the tool slide.

Further, even if the references can be combined such that, somehow, a gripper on a tool slide could be contemplated in Osburn, Applicant respectfully submits that such a combination would be improper. This modification of Osburn would change the principle of operation of Osburn. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. ¶ 2143.01 (VI). In Osburn, pallet engaging actuating arms 55 and 65 are associated with the pallet changer 44 and are used to change the pallets. The pallet changer 44, and consequently the arms 55 and 65, are located in the workpiece feed area, as acknowledged by the Examiner. Applicant respectfully submits that modification of Osburn to include a gripper on a tool slide would change the principle of operation of Osburn, which uses arms 55 and 65 of the pallet changer 44 in the workpiece feed area. As such, Applicant respectfully submits that the Examiner’s argued modification of Osburn is improper.

Lastly with respect to the Examiner’s argument for modification of Osburn regarding the claimed gripper, Applicant respectfully submits that “[t]he mere

fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of [Applicant's] specification, to make the necessary changes in the reference device.” M.P.E.P. ¶ 2144.04 (VI.C).

(emphasis added). Applicant respectfully submits that, as discussed above, there is no teaching in the prior art references for locating a gripper on a tool slide and that, therefore, the prior art does not provide the required motivation or reason for rearranging the parts. The mere fact that the parts can be rearranged is not by itself sufficient to support a finding of obviousness. Applicant respectfully submits that the only teaching to locate the gripper on the tool slide is found in Applicant's specification. Applicant also respectfully submits that, based on the above and contrary to the Examiner's argument, it has not been held that “rearranging parts of an invention involves only routine skill in the art.” The prior art must provide a motivation or reason to make the necessary changes, without the benefit of Applicant's specification. Therefore, for at least this additional reason, Applicant respectfully traverses the Examiner's rejection.

Further in this Amendment, Applicant has also added new dependent claims 12-14. These claims depend from now independent claim 8 and also correspond to dependent claims 2-3 and 7, respectively.

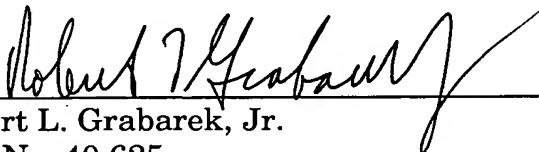
Applicant respectfully submits that the application is now in condition for allowance with claims 2-3 and 5-14 being allowable. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response. Please charge any such fee or any deficiency in fees, or credit any overpayment of fees, to Deposit Account No. 05-1323 (Docket 100975.53348US).

Respectfully submitted,

CROWELL & MORING LLP

Dated: May 17, 2006

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